

REMARKS

Claims 36-75 are pending in the Application. The information disclosure statement submitted on February 2, 2006 was objected to for failing to comply with 37 C.F.R. §1.98(a)(2). The drawings are objected to. The Specification is objected to. Claims 61 and 69-74 are objected to. Claims 36 and 37 are rejected on the ground of double patenting. Claim 75 is rejected on the ground of non-statutory obviousness-type double patenting. Claims 36-75 are rejected under 35 U.S.C. §103(a). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

I. INFORMATION DISCLOSURE STATEMENT:

The Examiner has indicated that the information disclosure statement submitted on February 2, 2006 failed to comply with 37 C.F.R. §1.98(a), which requires a legible copy of each cited foreign patent document as well as a legible copy for each non-patent literature publication or that portion which caused it to be listed. Office Action (7/10/2007), page 2. Applicants will be providing this information in a supplemental information disclosure statement.

II. OBJECTIONS TO DRAWINGS:

The Examiner has objected to Figure 1 as the Examiner believes that Figure 1 should be designated by the legend of "Prior Art." Office Action (7/10/2007), page 3. Applicants respectfully traverse and assert that Figure 1 is not directed to prior art embodiments. In fact, Applicants' Specification (page 7, lines 3-5) indicates that Figure 1 illustrates a teleconferencing system according to the preferred embodiment of the invention. Accordingly, Applicants respectfully request the Examiner to withdraw the objections to the drawings.

III. OBJECTIONS TO THE SPECIFICATION:

The Examiner has objected to the Specification as the preliminary amendment submitted on July 28, 2005 did not place the Abstract of the disclosure on a separate sheet. As indicated above, Applicants did place the Abstract of the disclosure on a separate sheet. Accordingly, Applicants respectfully request the Examiner to

withdraw the objections to the Specification.

IV. CLAIM OBJECTIONS:

The Examiner has indicated that if claim 62 should be found allowable that claim 61 would be objected under 37 C.F.R. §1.75 as being a substantial duplicate thereof. Office Action (7/10/2007), page 4. Applicants respectfully traverse.

Claim 61 is not a substantial duplicate of claim 62. Claim 61 includes limitations that are not recited in claim 62. For example, claim 61 recites "a logic circuit coupled (a) to the communications bus for disposition in the data path routing multimedia streams, (b) to the storage device, and (c) to the central processing unit; the logic circuit causing the multimedia stream accepted at the input interface to be routed to the storage device for recording and causing a recorded multimedia stream to be extracted from the storage device and routed to the output interface for playback, and the logic circuit further being capable of extracting the recorded multimedia stream for routing to the output interface for playback during routing of a different multimedia stream to the storage device for recording."

Further, the Examiner has indicated that if claims 55-60 should be found allowable that claims 69-74 would be objected under 37 C.F.R. §1.75 as being a substantial duplicate thereof. Office Action (7/10/2007), page 4. Applicants respectfully traverse.

Claim 69 is not a substantial duplicate of claim 55. Claim 55 includes limitations that are not recited in claim 69. For example, claim 55 recites "the multimedia stream routing and extracting means further being capable of extracting the multimedia stream from the storing means for playback during routing of a different multimedia stream to the storing means for recording."

As a result, Applicants respectfully request the Examiner to withdraw the objections to the claims.

V. DOUBLE PATENTING REJECTIONS:

The Examiner has rejected claims 36 and 37 based double patenting. Office Action (7/10/2007), page 5. In particular, the Examiner asserts that claims 36 and 37

have the same claim limitations as claims 1 and 3 of U.S. Patent No. 6,285,746. *Id.* Applicants respectfully traverse.

Claim 36 recites at least the following limitations not recited in claim 1 of U.S. Patent No. 6,285,746: "a central processing unit; a communications processor coupled to at least one source of video and audio signals and coupled to said central processing unit;...wherein said video and audio signals are capable of being supplied independently of the storage of another of said video and audio signals to said mass storage device based upon controls from said communications processor." Further, claim 1 of U.S. Patent No. 6,285,746 recites at least the following limitations not recited in claim 36: "a program memory coupled to said communication processing unit; ... wherein said video processing device is configured such that said video and audio received at said least one audio and video source is supplied and stored on said at least one mass storage device and further such that a video and audio signals that is stored on said at least one mass storage device are supplied to a video display and audio playback unit and wherein said supplied video and audio signals to the video display and audio playback unit from said at least one mass storage device is capable of being supplied independently of the storage of a video and audio signal to said mass storage device based upon a command from said communication central processing unit."

Hence, claims 36 and 37 are not claiming the same inventions as claims 1 and 3, respectively, of U.S. Patent No. 6,285,746. Accordingly, Applicants respectfully request the Examiner to withdraw the double patenting rejection.

Further, the Examiner rejects claim 75 on the ground of non-statutory obviousness-type double patenting based on claim 1 of U.S. Patent No. 6,285,746. Applicants respectfully traverse.

In determining whether a non-statutory basis exists for a double patenting rejection, the first question to be asked is—does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? M.P.E.P. §804. A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. §103" except that the

patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 U.S.P.Q. 29 (C.C.P.A. 1967); M.P.E.P. §804. Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985).

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. §103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. §103 are employed when making an obvious-type double patenting analysis. M.P.E.P. §804. However, the Examiner has not made any such inquiry. The Examiner has not made any factual inquiries (1) to determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue; (2) to determine the differences between the scope and content of the patent claim and the prior art as determined in (1) and the claim in the application at issue; (3) to determine the level of ordinary skill in the art; and (4) to evaluate any objective indicia of nonobviousness. M.P.E.P. §804. Any obviousness-type double patenting rejection should make clear the differences between the inventions defined by the conflicting claims—a claim in the patent compared to a claim in the application. M.P.E.P. §804. Further, any obviousness-type double patenting rejection should include reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. M.P.E.P. §804. The Examiner has not made clear the differences between the invention claimed in the application and the claim in the cited patent. Consequently, in view of the foregoing, the Examiner has not provided a basis for an obviousness-type double patenting rejection of claim 75. Thus, the rejection of claim 75 under obviousness-type double patenting is improper.

VI. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 36-43, 45-47 and 49-75 under 35 U.S.C. §103(a) as being unpatentable over Schwartz (U.S. Patent No. 4,682,248) in view of Rafner (U.S. Patent No. 4,972,396). The Examiner has further rejected claims 44 and 48 under 35 U.S.C. §103(a) as being unpatentable over Schwartz in view of Rafner and in further view of "New Video Coding Standard for the 1990s" (hereinafter "Carr"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

A. Claims 36-43, 45-47 and 49-75 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Schwartz in view of Rafner.

1. Schwartz and Rafner, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicants respectfully assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "a communication processor coupled to at least one source of video and audio signals and coupled to said central processing unit" as recited in claim 36. As understood by Applicants, the Examiner cites Figures 8 and 8A of Schwartz as teaching the above-cited claim limitation. Office Action (7/10/2007), page 6. Applicants respectfully traverse.

There is no depiction in Figures 8 and 8A of a communication processor coupled to at least one source of video and audio signals. Neither is there any depiction in Figures 8 and 8A of a communication processor coupled to a central processing unit. Applicants respectfully request the Examiner to particularly point out in Figures 8 and 8A of Schwartz where Schwartz allegedly teaches the above-cited claim limitation pursuant to 37 C.F.R. §1.104(c)(2). Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 36, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "at least one mass storage device having random

access capabilities being coupled to said communications processor" as recited in claim 36. As understood by Applicants, the Examiner cites Figures 8 and 8A of Schwartz as teaching the above-cited claim limitations. Office Action (7/10/2007), page 6. Applicants respectfully traverse.

There is no depiction in Figures 8 and 8A of a mass storage device having random access capabilities being coupled to the communications processor. Applicants respectfully request the Examiner to particularly point out in Figures 8 and 8A of Schwartz where Schwartz allegedly teaches the claimed mass storage device and the claimed communications processor pursuant to 37 C.F.R. §1.104(c)(2). Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 36, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "wherein said video processing device is configured such that video and audio signals are stored on said mass storage device and further such that video and audio signals that are stored on said mass storage device are supplied to a video display and audio playback unit" as recited in claim 36. The Examiner cites column 17, lines 23-45 of Schwartz as teaching the above-cited claim limitations. Office Action (7/10/2007), page 6. Applicants respectfully traverse.

Schwartz instead teaches that on playback, the audio and video data blocks are separated by the DRAM and sent to their respective processing buffer memories. Column 17, lines 30-32. Schwartz further teaches that the video data is synthesized by the inverse of the operations used for encoding. Column 17, lines 33-34. Additionally, Schwartz teaches that the synthesized data set is then converted from digital to analog form, conditioned, and outputted as an analog video signal for viewing on a television, or monitor with composite or RGB input capability. Column 17, lines 37-40.

There is no language in the cited passage that teaches a video processing device that is configured such that video and audio signals are stored on the mass

storage device. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 36, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "wherein said video and audio signals are capable of being supplied independently of the storage of another of said video and audio signals to said mass storage device based upon controls from said communications processor" as recited in claim 36. As understood by Applicants, the Examiner cites Figure 8 and column 6, lines 13-22 of Rafner as teaching the above-cited claim limitation. Office Action (7/10/2007), pages 6-7. Applicants respectfully traverse.

Rafner instead teaches that what the multi-head drive of the invention 200 allows the system to do is to receive data through the receiver enhancement circuitry 105 from one of the input sources and the long term storage, to send and receive information from the processing means 202 and then output processed or real time information to any or all of the output devices. Column 6, lines 13-19.

There is no language in the cited passage that teaches that the video and audio signals are capable of being supplied independently of the storage of another of the video and audio signals to the mass storage device. Neither is there any language in the cited passage that teaches that the video and audio signals are capable of being supplied independently of the storage of another of the video and audio signals to the mass storage device based upon controls from the communications processor. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 36, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "an input interface to accept an incoming stream of an individual multimedia presentation; an output interface to deliver an outgoing stream of an individual multimedia presentation to a multimedia playback device" as

recited in claim 38 and similarly in claims 49, 54, 61, 62 and 64. As understood by Applicants, the Examiner cites Figure 1 of Schwartz as teaching the above-cited claim limitations. Office Action (7/10/2007), page 7. Applicants respectfully traverse.

There is no depiction in Figure 1 that teaches an input interface to accept an incoming stream of an individual multimedia presentation. Neither is there any depiction of in Figure 1 that teaches an output interface to deliver an outgoing stream of an individual multimedia presentation to a multimedia playback device. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 38, 49, 54, 61, 62 and 64, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "a communications processor coupled (a) to the communications bus, (b) to the storage device, and (c) to the central processing unit; the communications processor causing the incoming stream to be routed to the storage device for recording and causing a recorded stream of an individual multimedia presentation to be extracted from the storage device and routed as the outgoing stream, and the communications processor further being capable of extracting the recorded stream from the storage device for routing to the output interface during routing of the incoming stream of the same individually multimedia presentation to the storage device for recording" as recited in claim 38. The Examiner has not addressed these limitations. Since the Examiner has not specifically addressed these limitations, the Examiner has not established a *prima facie* case of obviousness in rejecting claim 38. M.P.E.P. §2143.

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "a program memory; and processor circuitry coupled to the first bus, the second bus, and to the program memory; the processor circuitry controlling apparatus mode of operation, causing the multimedia stream accepted at the input interface to be routed to the storage device for recording and

causing the multimedia stream extracted from the storage device to be routed to the output interface for playback, and the processor circuitry further being capable of extracting a recorded multimedia stream from the storage device for routing to the output interface during routing of a different multimedia stream to the storage device for recording" as recited in claim 49. The Examiner has not addressed these limitations. Since the Examiner has not specifically addressed these limitations, the Examiner has not established a *prima facie* case of obviousness in rejecting claim 49. M.P.E.P. §2143.

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "a central processing unit controlling apparatus mode of operation; a communications bus coupled to the input interface and to the output interface to establish a data path for routing of incoming and outgoing multimedia streams" as recited in claim 54. The Examiner has not addressed these limitations. Since the Examiner has not specifically addressed these limitations, the Examiner has not established a *prima facie* case of obviousness in rejecting claim 54. M.P.E.P. §2143.

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "a co-processor in the data path for routing multimedia streams, the co-processor causing the incoming multimedia stream to be routed to the storage device for recording and causing a multimedia stream extracted from the storage device to be routed to the output interface, and the co-processor further being capable of extracting the multimedia stream from the storage device for routing to the output interface during routing of a different multimedia stream to the storage device for recording" as recited in claim 54. As understood by Applicants, the Examiner cites column 8, lines 51-68 of Schwartz as teaching the above-cited claim limitations. Office Action (7/10/2007), page 8. Applicants respectfully traverse.

Schwartz instead teaches that assembled disk records from the DRA are the input for the Disk Read/Write module. Column 8, lines 51-52. Schwartz further teaches that in the "write" mode, records in the form of the data stream format previously described, will be written to disk storage as long as there is space

available. Column 8, lines 52-55.

There is no language in the cited passage that teaches a co-processor in the data path for routing multimedia streams. Neither is there any language in the cited passage that teaches that the co-processor causes the incoming multimedia stream to be routed to the storage device for recording. Neither is there any language in the cited passage that teaches that the co-processor causes a multimedia stream extracted from the storage device to be routed to the output interface. Neither is there any language in the cited passage that teaches that the co-processor further being capable of extracting the multimedia stream from the storage device for routing to the output interface during routing of a different multimedia stream to the storage device for recording. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 54, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "means for establishing a data path for a received multimedia stream of an individual multimedia presentation and for establishing a data path for the multimedia stream for playback; means in the data path for the multimedia stream for routing the multimedia stream to the storing means for recording, and for extracting the multimedia stream from the storing means for playback; the multimedia stream routing and extracting means further being capable of extracting the multimedia stream from the storing means for playback during routing of a different multimedia stream to the storing means for recording" as recited in claim 55. The Examiner has not addressed these limitations. Since the Examiner has not specifically addressed these limitations, the Examiner has not established a *prima facie* case of obviousness in rejecting claim 55. M.P.E.P. §2143.

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "a logic circuit coupled (a) to the communications bus for disposition in the data path routing multimedia streams, (b) to the storage device, and (c) to the central processing unit; the logic circuit causing

the multimedia stream accepted at the input interface to be routed to the storage device for recording and causing a recorded multimedia stream to be extracted from the storage device and routed to the output interface for playback; and the logic circuit further being capable of extracting the recorded multimedia stream for routing to the output interface for playback during routing of a different multimedia stream to the storage device for recording" as recited in claim 61. As understood by Applicants, the Examiner cites column 8, lines 51-68 of Schwartz as teaching the above-cited claim limitations. Office Action (7/10/2007), page 8. Applicants respectfully traverse.

Schwartz instead teaches that assembled disk records from the DRA are the input for the Disk Read/Write module. Column 8, lines 51-52. Schwartz further teaches that in the "write" mode, records in the form of the data stream format previously described, will be written to disk storage as long as there is space available. Column 8, lines 52-55.

There is no language in the cited passage that teaches a logic circuit coupled (a) to the communications bus for disposition in the data path routing multimedia streams, (b) to the storage device, and (c) to the central processing unit. Neither is there any language in the cited passage that teaches the logic circuit causing the multimedia stream accepted at the input interface to be routed to the storage device for recording. Neither is there any language in the cited passage that teaches the logic circuit causing a recorded multimedia stream to be extracted from the storage device and routed to the output interface for playback. Neither is there any language in the cited passage that teaches the logic circuit further being capable of extracting the recorded multimedia stream for routing to the output interface for playback during routing of a different multimedia stream to the storage device for recording. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 61, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "a communications processor coupled (a) to the

communications bus for disposition in the data path for routing of the multimedia streams, (b) to the storage device, and (c) to the central processing unit; the communications processor causing the multimedia stream accepted at the input interface to be routed to the storage device for recording, and the communications processor further being capable of extracting a recorded multimedia stream of an individual multimedia presentation from the storage device for routing to the output interface for playback" as recited in claim 62. As understood by Applicants, the Examiner cites column 8, lines 51-68 of Schwartz as teaching the above-cited claim limitations. Office Action (7/10/2007), page 8. Applicants respectfully traverse.

Schwartz instead teaches that assembled disk records from the DRA are the input for the Disk Read/Write module. Column 8, lines 51-52. Schwartz further teaches that in the "write" mode, records in the form of the data stream format previously described, will be written to disk storage as long as there is space available. Column 8, lines 52-55.

There is no language in the cited passage that teaches a communications processor coupled (a) to the communications bus for disposition in the data path for routing of the multimedia streams, (b) to the storage device, and (c) to the central processing unit. Neither is there any language in the cited passage that teaches the communications processor causing the multimedia stream accepted at the input interface to be routed to the storage device for recording. Neither is there any language in the cited passage that teaches the communications processor further being capable of extracting a recorded multimedia stream of an individual multimedia presentation from the storage device for routing to the output interface for playback. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 62, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "the processor circuitry controlling apparatus mode of operation and causing the multimedia stream accepted at the input interface to be routed to the storage device for recording, and the processor circuitry being

capable of extracting a recorded multimedia stream of an individual multimedia presentation from the storage device for routing to the output interface for playback" as recited in claim 64. As understood by Applicants, the Examiner cites column 6, lines 9-19 of Rafner as teaching the above-cited claim limitations. Office Action (7/10/2007), page 9. Applicants respectfully traverse.

Rafner instead teaches that processing of data in the form of editing, captioning enhancement analysis or compression/decompression through processing means 202 is also well known in the art. Column 6, lines 9-12.

There is no language in the cited passage that teaches the processor circuitry controlling apparatus mode of operation and causing the multimedia stream accepted at the input interface to be routed to the storage device for recording. Neither is there any language in the cited passage that teaches that the processor circuitry being capable of extracting a recorded multimedia stream of an individual multimedia presentation from the storage device for routing to the output interface for playback. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 64, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "means for establishing a data path for (1) a received multimedia stream of an individual multimedia presentation and for (2) a multimedia stream of an individual multimedia presentation being delivered for playback; means for storing a multimedia stream of an individual multimedia presentation; and means for routing the stored multimedia stream for recording" as recited in claim 69. The Examiner has not addressed these limitations. Since the Examiner has not specifically addressed these limitations, the Examiner has not established a *prima facie* case of obviousness in rejecting claim 69. M.P.E.P. §2143.

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "the multimedia stream routing means further being capable of extracting the stored multimedia stream from the storing means for playback" as recited in claim 69. As understood by Applicants, the Examiner cites

column 6, lines 9-19 of Rafner as teaching the above-cited claim limitations. Office Action (7/10/2007), page 9. Applicants respectfully traverse.

Rafner instead teaches that processing of data in the form of editing, captioning enhancement analysis or compression/decompression through processing means 202 is also well known in the art. Column 6, lines 9-12.

There is no language in the cited passage that teaches that the multimedia stream routing means further being capable of extracting the stored multimedia stream from the storing means for playback. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 69, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "accepting a multimedia stream of an individual multimedia presentation; routing the accepted multimedia stream to a storage device for recording; and extracting the recorded multimedia stream from the storage device for delivery to a multimedia playback device while a different multimedia stream is being routed to the storage device for recording" as recited in claim 75.

As understood by Applicants, the Examiner asserts that Schwartz and Rafner teach the above-cited claim limitations without providing any evidence. Office Action (7/10/2007), page 10. The Examiner must provide evidence that Schwartz and Rafner teach the above-cited claim limitations. The Examiner is reminded that the Examiner bears the initial burden and must submit objective evidence and not rely on his own subjective opinion in support of a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). Since the Examiner has not provided any evidence that Schwartz and Rafner teach the above-cited claim limitations, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 75. M.P.E.P. §2143.

Claim 37 recites the combinations of features of independent claim 36, and hence claim 37 is patentable over Schwartz in view of Rafner for at least the above-stated reasons that claim 36 is patentable over Schwartz in view of Rafner.

Further, claims 39-43 and 45-48 each recite combinations of features of independent claim 38, and hence claims 39-43 and 45-48 are patentable over Schwartz in view of Rafner for at least the above-stated reasons that claim 38 is patentable over Schwartz in view of Rafner.

Additionally, claims 50-53 each recite combinations of features of independent claim 49, and hence claims 50-53 are patentable over Schwartz in view of Rafner for at least the above-stated reasons that claim 49 is patentable over Schwartz in view of Rafner.

Furthermore, claims 56-60 each recite combinations of features of independent claim 55, and hence claims 56-60 are patentable over Schwartz in view of Rafner for at least the above-stated reasons that claim 55 is patentable over Schwartz in view of Rafner.

Additionally, claim 63 recites the combinations of features of independent claim 62, and hence claim 63 is patentable over Schwartz in view of Rafner for at least the above-stated reasons that claim 62 is patentable over Schwartz in view of Rafner.

Further, claims 65-68 each recite combinations of features of independent claim 64, and hence claims 65-68 are patentable over Schwartz in view of Rafner for at least the above-stated reasons that claim 64 is patentable over Schwartz in view of Rafner.

Furthermore, claims 70-74 each recite combinations of features of independent claim 69, and hence claims 70-74 are patentable over Schwartz in view of Rafner for at least the above-stated reasons that claim 69 is patentable over Schwartz in view of Rafner.

Claims 37, 39-43, 45-48, 50-53, 56-60, 63, 65-68 and 70-74 recite additional features, which, in combination with the features of the claims upon which they depend, are patentable over Schwartz in view of Rafner.

For example, Schwartz and Rafner, taken singly or in combination, do not teach or suggest "wherein the recorded multimedia stream is extracted from the

storage device at a time removed from the recording of the recorded multimedia stream" as recited in claim 39. As understood by Applicants, the Examiner asserts that Rafner teaches the above-cited claim limitation without providing any evidence. Office Action (7/10/2007), page 7. The Examiner must provide evidence that Rafner teaches the above-cited claim limitation. The Examiner is reminded that the Examiner bears the initial burden and must submit objective evidence and not rely on his own subjective opinion in support of a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). Since the Examiner has not provided any evidence that Rafner teaches the above-cited claim limitation, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 39. M.P.E.P. §2143.

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "wherein any of the individual multimedia presentations comprises audio and video" as recited in claim 40 and similarly in claim 50. The Examiner cites the Abstract of Schwartz as teaching the above-cited claim limitation. Office Action (7/10/2007), pages 7-8. Applicants respectfully traverse.

Schwartz instead teaches converting an analog signal, such as an audio or video signal representative of sound or video into a digital form. Abstract.

There is no language in the cited passage that teaches that any of the individual multimedia presentations comprises audio and video. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 40 and 50, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "wherein the communications processor comprises a reduced instruction set computing (RISC) processor" as recited in claim 41. The Examiner cites column 5, line 61 of Schwartz as teaching the above-cited claim limitation. Office Action (7/10/2007), page 8. Applicants respectfully traverse.

Schwartz instead teaches that the recording of the audio signals into a digital form for subsequent playback is accomplished by the provision of a microcomputer recording system. Column 5, lines 59-61.

There is no language in the cited passage that teaches that the communications processor comprises a reduced instruction set computing (RISC) processor. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 41, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "wherein the central processing unit comprises a general-purpose microprocessor" as recited in claim 42 and similarly in claim 51. The Examiner cites column 9, lines 30-32 of Schwartz as teaching the above-cited claim limitation. Office Action (7/10/2007), page 8. Applicants respectfully traverse.

Schwartz instead teaches that a most preferred embodiment of the system will employ Very Large Scale Integrated Circuit (VLSIs) technology to reduce logical groupings of circuit to single semiconductor chips, as opposed to the schematic representation shown in Figure 5 which utilizes many "off the shelf" integrated circuit components. Column 9, lines 27-32.

There is no language in the cited passage that teaches that the central processing unit comprises a general-purpose microprocessor. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 42 and 51, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "wherein the input interface accepts the incoming stream in a digital form" as recited in claim 46 and similarly in claims 53 and 68. The Examiner cites column 6, lines 50-68 of Rafner as teaching the above-cited claim limitation. Office Action (7/10/2007), page 8. Applicants respectfully traverse.

Rafner instead teaches that an excellent example of one such application would be a TV field crew wishing to transmit "raw feed" back to the production studio for incorporation into the evening news. Column 6 lines 50-53. Rafner further teaches that the cheapest method of data transmission is over an industry standard, fixed bandwidth, packet switching network. Column 6, lines 53-55. Rafner additionally teaches that in this case, typically a 384Kb type "H" channel. Column 6, lines 55-56.

There is no language in the cited passage that teaches that the input interface accepts the incoming stream in a digital form. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 45, 53 and 68, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "wherein the communications processor comprises logic circuitry implemented in an integrated circuit package" as recited in claim 47. The Examiner cites column 9, lines 27-30 of Schwartz as teaching the above-cited claim limitation. Office Action (7/10/2007), page 8. Applicants respectfully traverse.

Schwartz instead teaches that a most preferred embodiment of the system will employ Very Large Scale Integrated Circuit (VLSIs) technology to reduce logical groupings of circuit to single semiconductor chips, as opposed to the schematic representation shown in Figure 5 which utilizes many "off the shelf" integrated circuit components. Column 9, lines 27-32.

There is no language in the cited passage that teaches that the communications processor comprises logic circuitry implemented in an integrated circuit package. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 47, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "wherein the multimedia stream routing and

extracting means is disposed in the data path between an input interface and an output interface" as recited in claim 56 and similarly in claim 70. The Examiner cites Figure 1 of Schwartz as teaching the above-cited claim limitation. Office Action (7/10/2007), pages 8-9. Applicants respectfully traverse.

There is no depiction in Figure 1 that teaches a multimedia stream routing and extracting means that is disposed in the data path between an input interface and an output interface. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 56 and 70, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "wherein the storing means comprises a random access disk storage medium" as recited in claim 60 and similarly in claim 74. The Examiner cites column 14, lines 56-64 of Schwartz as teaching the above-cited claim limitation. Office Action (7/10/2007), page 9. Applicants respectfully traverse

Schwartz instead teaches that in the application of the present invention to video digital recording and playback, the preferred format for a floppy disk is at least 640 tracks. Column 14, lines 56-58. Schwartz further teaches that the entire memory space can then be accessible within ½ second or less to allow continuous motion playback that includes jump-cut splices anywhere in the recorded material. Column 14, lines 58-61.

There is no language in the cited passage that teaches that the storing means comprises a random access disk storage medium. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 60 and 74, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Schwartz and Rafner, taken singly or in combination, do not teach or suggest "wherein the processor is further capable of extracting the multimedia stream during routing of a different multimedia stream of the same individual multimedia presentation to the storage device for recording" as

recited in claim 66. The Examiner cites column 5, lines 2-4 of Rafner as teaching the above-cited claim limitation. Office Action (7/10/2007), page 9. Applicants respectfully traverse.

Rafner instead teaches that the dual recording-reading heads would provide the additional capability to record and/or play two inputs simultaneously. Column 5, lines 2-4. There is no language in the cited passage that teaches that the processor is further capable of extracting the multimedia stream during routing of a different multimedia stream. Neither is there any language in the cited passage that teaches that the processor is further capable of extracting the multimedia stream during routing of a different multimedia stream of the same individual multimedia presentation to the storage device for recording. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 66, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

As a result of the foregoing, Applicants respectfully assert that there are numerous claim limitations not taught or suggested in Schwartz in view of Rafner, and thus the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 36-43, 45-47 and 49-75. M.P.E.P. §2143.

2. Examiner's motivation for modifying Schwartz with Rafner to include the missing claim limitations of claims 36, 37, 63 and 65 is insufficient to establish a *prima facie* case of obviousness.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references

for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

As understood by the Applicants, the Examiner admits that Schwartz does not teach "wherein said video and audio signals are capable of being supplied independently of the storage of another of said video and audio signals to said mass storage device based upon controls from said communications processor" as recited in claim 36. Office Action (7/10/2007), pages 6-7. As further understood by Applicants, the Examiner admits that Schwartz does not teach "wherein said stored video and audio signals is supplied to said video display and audio playback unit at a time removed from said storage of said video and audio signal" as recited in claim 37 and similarly in claims 63 and 65. *Id.* at page 7. The Examiner asserts that Rafner teaches the above-cited missing claim limitations. *Id.* at pages 6-7. The Examiner's reasoning for modifying Schwartz with Rafner to include the above-cited missing claim limitations is to "enable reading, writing, and editing multiple streams of data simultaneously." *Id.* at page 7. The Examiner's reasoning is insufficient to establish a *prima facie* case of obviousness in rejecting claims 36, 37, 63 and 65.

The Examiner cites column 2, lines 9-12 of Rafner as support for the Examiner's reasoning for modifying Schwartz with Rafner to include the missing claim limitations of claims 36, 37, 63 and 65. Office Action (7/10/2007), page 7. Rafner teaches that in these very demanding applications, the flexibility of the invention to simultaneously read, write and alter several high bandwidth streams of data simultaneously would be invaluable. Column 2, lines 9-12. There is no language in Rafner (and in particular column 2, lines 9-12) that makes any suggestion to: (1) have the video and audio signals be capable of being supplied independently of the storage of another of the video and audio signals to the mass storage device based upon controls from the communications processor; (2) have the stored video and audio signals be supplied to the video display and audio playback unit at a time removed from the storage of the video and audio signal (missing claim limitations) in order to have the flexibility to simultaneously read, write and alter several high

bandwidth streams of data. The Examiner has simply cited to an arbitrary passage in Rafner that discusses an object of the invention in Rafner and then concludes that the Examiner has provided appropriate reasoning. The Examiner has to provide some rational connection between the cited passage that is the source of the Examiner's reasoning and the missing claim limitations. The Examiner's source of reasoning (column 2, lines 9-12 of Rafner) does not provide reasons as to why one skilled in the art would modify Schwartz to include the missing claim limitations of claims 36, 37, 63 and 65. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 36, 37, 63 and 65. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

Furthermore, the Examiner's rationale ("to have the flexibility to simultaneously read, write and alter several high bandwidth streams of data") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Schwartz to include the missing claim limitations of claims 36, 37, 63 and 65. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 36, 37, 63 and 65. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

Schwartz addresses the problem of storing high quality digital video and audio data in a readily accessible, durable, and inexpensive form. Column 3, lines 37-39. The Examiner has not provided any reasons as to why one skilled in the art would modify Schwartz (which teaches storing high quality digital video and audio data in a readily accessible, durable, and inexpensive form) to: (1) have the video and audio signals be capable of being supplied independently of the storage of another of the video and audio signals to the mass storage device based upon controls from the communications processor; (2) have the stored video and audio signals be supplied to the video display and audio playback unit at a time removed from the storage of the video and audio signal (missing claim limitations). The Examiner's rationale ("to have the flexibility to simultaneously read, write and alter several high bandwidth streams of data") does not provide such reasoning.

Why would the reason to modify Schwartz (whose purpose is to store high quality digital video and audio data in a readily accessible, durable, and inexpensive form) to: (1) have the video and audio signals be capable of being supplied independently of the storage of another of the video and audio signals to the mass storage device based upon controls from the communications processor; (2) have the stored video and audio signals be supplied to the video display and audio playback unit at a time removed from the storage of the video and audio signal (missing claim limitations) be to have the flexibility to simultaneously read, write and alter several high bandwidth streams of data? Schwartz is not concerned with having the flexibility to simultaneously read, write and alter several high bandwidth streams of data. The Examiner cannot completely ignore the teachings of Schwartz in concluding it would have been obvious to modify Schwartz to include the missing claim limitations of claims 36, 37, 63 and 65.¹ Further, what is the rational connection between the missing claim limitations and having the flexibility to simultaneously read, write and alter several high bandwidth streams of data (Examiner's reasoning)? Hence, the Examiner's reasoning does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Schwartz to include the missing claim limitations of claims 36, 37, 63 and 65. Accordingly, the Examiner has

¹ For example, suppose that the invention of a super soaker gun (essentially a plastic gun that shoots water) was never developed and an Applicant filed for a patent application on the super soaker gun. Applicant claims a plastic gun with a container of water that shoots water. The Examiner cites a primary reference that teaches a plastic gun that shoots darts and cites a secondary reference that teaches a plastic toy that contains a container of water. Since the primary reference does not teach a container filled with water, the Examiner cites the secondary reference as teaching this missing claim limitation. The secondary reference specifically states that the purpose of the container is to carry water. The Examiner then concludes that it would have been obvious to modify the primary reference with the secondary reference in order to carry water. The Examiner believes that he/she has established a *prima facie* case of obviousness since the Examiner has found a reason to have a container of water. However, the Examiner is completely ignoring the teaching of the primary reference. Why would one skilled in the art modify a plastic gun that shoots darts to have a container of water? This is the key question to answer. While having a container of water may be used to carry water, that is irrelevant as far as the purpose of the primary reference. Simply citing to a passage in the secondary reference that discusses the purpose of that secondary reference may not be sufficient evidence for an obviousness rejection. After all, surely there is a reason as to why the secondary reference teaches the missing claim limitation or else why would it include it? The Examiner must explain the connection between the teachings of the primary reference and rationale of the secondary reference for including the missing claim limitation. Otherwise, everything can be deemed obvious and virtually nothing can be patented.

not presented a *prima facie* case of obviousness for rejecting claims 36, 37, 63 and 65. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

3. Examiner has not provided a rationale underpinning for modifying Schwartz with Rafner to include the missing claim limitations of claims 38, 39, 45, 49, 54, 55, 61, 62, 64, 66-68, 69 and 75 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

As understood by Applicants, the Examiner admits that Schwartz does not teach all of the limitations of claims 38, 49, 54, 55, 61, 62, 69 and 75. However, the Examiner has not specifically identified which limitations of claims 38, 49, 54, 55, 61, 62, 69 and 75 are not taught by Schwartz. Further, as understood by Applicants, the Examiner asserts that Rafner teaches these missing claim limitations. Applicants respectfully request the Examiner to particularly point out which limitations in claims 38, 49, 54, 55, 61, 62, 69 and 75 are not taught by Schwartz and are allegedly taught by Rafner pursuant to 37 C.F.R. §1.104(c)(2). Further, the Examiner has not provided any rational underpinning for modifying Schwartz to include the missing claim limitations of claims 38, 49, 54, 55, 61, 62, 69 and 75. Hence, the Examiner has not

provided a *prima facie* case of obviousness in rejecting claims 38, 49, 54, 55, 61, 62, 69 and 75. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

As further understood by Applicants, the Examiner admits that Schwartz does not teach the claim limitations of claims 39, 45, 64 and 66-68. Office Action (7/10/2007), pages 7-9. The Examiner asserts that Rafner teaches these missing claim limitations. *Id.* However, the Examiner has not provided any rational underpinning for modifying Schwartz with Rafner to include these missing claim limitations of claims 39, 45, 64 and 66-68. Hence, the Examiner has not provided a *prima facie* case of obviousness in rejecting claims 39, 45, 64 and 66-68. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

- B. Claims 44 and 48 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Schwartz in view of Rafner and in further view of Carr.

As stated above, most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

As understood by the Applicants, the Examiner admits that Schwartz does not teach "wherein the output interface implements a discrete cosine transform video

decoding of the recorded stream for delivery to the multimedia playback device" as recited in claim 44. Office Action (7/10/2007), page 10. As further understood by Applicants, the Examiner admits that Schwartz does not teach "wherein the output interface comprises a decoder performing a decompression algorithm based on a discrete cosine transform and motion estimation" as recited in claim 48. *Id.* The Examiner asserts that Carr teaches the above-cited missing claim limitations. *Id.* The Examiner's reasoning for modifying Schwartz with Carr to include the above-cited missing claim limitations is to "enable video to be transmitted over a 64 kb/s transmission line." *Id.* at page 11. The Examiner's reasoning is insufficient to establish a *prima facie* case of obviousness in rejecting claims 44 and 48.

The Examiner cites page 120, column 3 of Carr as support for the Examiner's reasoning for modifying Schwartz with Carr to include the missing claim limitations of claims 44 and 48. Office Action (7/10/2007), page 10. Carr teaches that the draft CCITT standard H.261 covers all bit rates from 64 kbit/s up to 2 Mbit/s. Page 120, column 3. There is no language in Carr (and in particular page 120, column 3) that makes any suggestion to: (1) have the output interface implements a discrete cosine transform video decoding of the recorded stream for delivery to the multimedia playback device; (2) have the output interface comprises a decoder performing a decompression algorithm based on a discrete cosine transform and motion estimation (missing claim limitations) in order to enable video to be transmitted over a 64 kb/s transmission line. The Examiner has simply cited to an arbitrary passage in Carr that discusses that a draft of the H.261 standard covers all bit rates from 64 kbit/s up to 2 Mbit/s. The Examiner has to provide some rational connection between the cited passage that is the source of the Examiner's reasoning and the missing claim limitations. The Examiner's source of reasoning (page 120, column 3 of Carr) does not provide reasons as to why one skilled in the art would modify Schwartz to include the missing claim limitations of claims 44 and 48. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 44 and 48. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

Furthermore, the Examiner's rationale ("to enable video to be transmitted over a 64 kb/s transmission line") does not provide reasons, as discussed further below,

that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Schwartz to include the missing claim limitations of claims 44 and 48. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 44 and 48. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

Schwartz addresses the problem of storing high quality digital video and audio data in a readily accessible, durable, and inexpensive form. Column 3, lines 37-39. The Examiner has not provided any reasons as to why one skilled in the art would modify Schwartz (which teaches storing high quality digital video and audio data in a readily accessible, durable, and inexpensive form) to: (1) have the output interface implements a discrete cosine transform video decoding of the recorded stream for delivery to the multimedia playback device; (2) have the output interface comprises a decoder performing a decompression algorithm based on a discrete cosine transform and motion estimation (missing claim limitations). The Examiner's rationale ("to enable video to be transmitted over a 64 kb/s transmission line") does not provide such reasoning.

Why would the reason to modify Schwartz (whose purpose is to store high quality digital video and audio data in a readily accessible, durable, and inexpensive form) to: (1) have the output interface implements a discrete cosine transform video decoding of the recorded stream for delivery to the multimedia playback device; (2) have the output interface comprises a decoder performing a decompression algorithm based on a discrete cosine transform and motion estimation (missing claim limitations) be to enable video to be transmitted over a 64 kb/s transmission line? Schwartz is not concerned with enabling video to be transmitted over a 64 kb/s transmission line. The Examiner cannot completely ignore the teachings of Schwartz in concluding it would have been obvious to modify Schwartz to include the missing claim limitations of claims 44 and 48. Further, what is the rational connection between the missing claim limitations and enabling video to be transmitted over a 64 kb/s transmission line (Examiner's reasoning)? Hence, the Examiner's reasoning does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Schwartz to

include the missing claim limitations of claims 44 and 48. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 44 and 48. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

VII CONCLUSION:

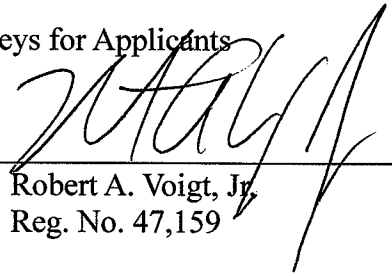
As a result of the foregoing, it is asserted by Applicants that claims 36-75 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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